

#### REMARKS

Reconsideration of this application is respectfully requested.

Claims 283-328 were previously pending in this application. Of the previously pending claims, claim 283 has been cancelled and claims 284, 293 and 327 have been amended. New claims 329-336 have been added. Accordingly, claims 284-336 are presented for further examination.

A new title has been substituted that is believed to be more descriptive of the presently claimed invention.

A number of informalities in the specification have been corrected in response to the Examiner's remarks on pages 11 and 12 in the instant Office Action. Applicants and their undersigned attorney sincerely appreciate that the Examiner has brought attention to these matters, the correction of which is believed to make the present disclosure more readable.

Claims 284, 293 and 327 have each been amended to define more clearly the present invention. In claim 284, the first step (a) has been changed to recite "hybridizing said nucleic acid of interest in the sample with an oligo- or polynucleotide. . . ." In addition, the last step (b) has been amended to recite that what is being detected is the presence of Sig in any of the oligo- or polynucleotides hybridized to the nucleic acid of interest. As now amended, claim 293 recites "wherein Sig comprises a sugar residue and the sugar residue is complexed with or attached to a sugar binding protein or a polysaccharide binding protein." Finally, in claim 327, the language has been amended to recite "at least one uracil moiety has been modified by chemical addition of Sig to the 5' position of said uracil moiety." It is respectfully submitted that all of the foregoing amendments are fully supported by the original disclosure.

Commensurate with their broad and complete disclosure, Applicants are presenting new claims 329-336 for examination in this application. All of the newly-added claims are directed to a process for determining the sequence of a nucleic acid of interest using one or more modified nucleotides disclosed in the original application. It is respectfully submitted that the subject matter of claims 329-336 is

fully supported by the original disclosure and furthermore constitutes subject matter that Applicants are duly entitled to claim.

Applicants note the Examiner's remarks concerning the two Information Disclosure Statements filed on June 28, 1993 and September 28, 1995 and the fact that copies of some references were not submitted for certain citations. Accordingly, these references were not considered by the Examiner. Applicants will obtain copies of the missing references and will submit copies of them in a future supplemental filing. As noted by the Examiner, two patents have issued in the family to which the present application belongs. These include U.S. Patent Nos. 5,260,060 and 5,260,433, that issued on August 31, 1993 and November 9, 1993, respectively. The former '060 Patent was previously submitted in an Information Disclosure Statement; the latter '433 Patent was not. Applicants are submitting, therefore, a copy of the '433 Patent as Exhibit 1 for the Examiner's information and convenience.

**The Objection and Rejection Under 35 U.S.C § 112, First Paragraph**

The specification stands objected to and claims 284-328 were rejected under 35 U.S.C. § 112, 1st Paragraph, for allegedly not filing support for the invention as is now claimed. The Examiner's remarks are set forth on page 3 of the Office Action.

The objection and rejection is respectfully traversed.

In response, Applicants' respectfully submit that the presently claimed subject matter is fully supported by the original disclosure and does not constitute the insertion of new matter.

In addition, Applicants would like to point out that the U.S. Patent and Trademark Office has already deemed the subject matter at issue as being fully supported by the original disclosure. This is clearly evidenced by the two U.S. patents, U.S. Patent Nos. 5,241,060 and 5,260,433, that issued in 1993. Applicants would like to draw attention to claim 1 in the aforementioned '060 Patent that recites: "Sig is covalently attached to BASE at a position other than the C<sup>5</sup> position when BASE is pyrimidine, at a position other than the C<sup>8</sup> position when

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deazapurine and wherein Sig represents a detectable moiety."

Reconsideration and withdrawal of the objection and rejection is respectfully requested.

**The Rejection Under 35 U.S.C. § 112, First Paragraph**

Claims 284-328 stand rejected for allegedly being nonenabling for the claims. The Examiner's remarks are set forth on pages 4-6 of Office Action.

This rejection is respectfully traversed.

It is respectfully submitted that the disclosure fully enables the claimed subject matter. Applicants intend to submit information supplementing this response, but in the meantime, they would like to draw attention to the fact that the subject matter and claim language has already been deemed enabling by the U.S. Patent and Trademark Office in the form of the already issued and related patents.

Reconsideration and withdrawal of this rejection is respectfully requested.

**The Rejection of 35 U.S.C. § 112, First Paragraph**

Claims 284-328 stand rejected under 35 U.S.C §112, first paragraph, as the disclosure is allegedly enabling only for claims limited to SM moieties which are either ribose or deoxyribose.

This rejection is respectfully traversed.

In response, Applicants believe that the present claims are fully enabled by the original disclosure.

Reconsideration of this rejection is respectfully requested.

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**The Rejection Under 35 U.S.C. §112, Second Paragraph**

Claims 283-328 stand rejected for indefiniteness. The Examiner's remarks are set forth on pages 8-11 of the Office Action. As noted above, claim 283 has been cancelled and claims 284, 293 and 327 have been amended.

It is believed that the foregoing cancellation and above amendment to the three claims in question obviate the indefiniteness rejection. Reconsideration and withdrawal of this rejection is respectfully requested.

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SUMMARY AND CONCLUSIONS

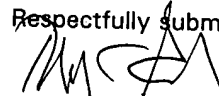
Claims 284-336 are presented for further examination. Claim 283 has been cancelled and new claims 329-336 have been added. Claims 284, 293 and 327 have been amended. No other claims have been otherwise affected by this Amendment.

This Amendment is accompanying as Exhibit B a Petition to Revive An Unintentionally Abandoned Application Under 37 C.F.R § 1.137(b) and authorization for the fee therefor. The fee for adding new claims 329-336, including the first presentation of multiple dependent claims, is \$414.00, based upon seven new claims ( $7 \times \$22 = \$154$ , and the first presentation of multiple dependent claims (\$260)). Authorization is hereby given to charge the amount of \$414.00 to the Deposit Account No. 05-1135. No other fee is believed to be due for this Amendment or the accompanying Petition. If any other fee is due, however, the Patent and Trademark Office is authorized to charge the amount of any such other fee(s) to Deposit Account No. 05-1135, and to credit any overpayment thereto.

In view of the above discussion of the issues and amendments to the claims, and the submitted exhibits, Applicants respectfully submit that all of the instant claims are in allowable condition. Should it be deemed helpful or necessary, the Examiner is respectfully invited to telephone the undersigned at (212) 583-0100 to discuss the subject application.

In view of the above amendments to the claims, the discussion of the issues and the submission of the new claims, Applicants respectfully submit that all of the present claims (284-336) are in allowable condition. Should it be deemed helpful or necessary, the Examiner is respectfully invited to telephone the undersigned at (212) 583-0100 to discuss the subject application.

Respectfully submitted,



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